

REMARKS

Claims 1 to 8 are now pending.

Reconsideration is respectfully requested based on the following.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for allowing claims 6 to 8.

Claims 1 to 5 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

As an initial matter, it is respectfully submitted that the Office Action does not set forth a *prima facie* case of unpatentability. The office bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). As stated in M.P.E.P. § 2106, “if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation” (emphasis added).

The Office Action merely states that “[s]ince there is no physical transform to establish a practical application, a useful, concrete and tangible result appears to be lacking” (emphasis in original). The guidelines, however, state that “[a] claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it: (A) ‘transforms’ an article or physical object to a different state or thing; or (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.” M.P.E.P. 2106 (emphasis added). In contrast to what has been asserted in the Office Action, the lack of a physical transform does **not** establish a lack of a useful, concrete and tangible result. Rather, these are two separate tests, each of which will demonstrate a practical application of a 35 U.S.C. § 101 judicial exception.

It is respectfully submitted that claim 1 provides a physical transform. Claim 1 recites, in relevant part, “**applying** a control signal to a correction device connected between at least one of the two comparing devices and a logic device” and “**gating** the two intermediate comparison results in the logic device, depending on the control signal applied to the correction device, wherein an output of the logic device is provided as an overall result.” Applying the control signal to the correction device transforms the correction device by opening and closing electrical gates within the correction device. Furthermore, gating the

logic device transforms the logic device by opening and closing electrical gates within the logic device to provide the overall result.

Separately, claim 1 provides a useful, concrete and tangible result. M.P.E.P. § 2106 further states “abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods . . . employing abstract ideas, natural phenomena, and laws of nature to **perform a real-world function may well be**” (emphasis added). While claim 1 may recite a method for performing a mathematical function, as alleged by the Office Action, the method according to claim 1 produces a useful, concrete and tangible result to constitute a practical application of an abstract idea, law of nature or natural phenomena. As stated in M.P.E.P. § 2106, “the focus is not whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved . . . is ‘useful, tangible, and concrete.’”

For a claim to be “useful,” it must satisfy the utility requirement, i.e., specific, substantial and credible utility must be provided. As explained above, it is the Office’s burden to present a *prima facie* case of unpatentability. There is nothing in the record to indicate or suggest whether or why claim 1 may be considered to not satisfy the utility requirement. It is respectfully submitted that a comparison result produced by claim 1 is a useful result and may be used in at least one practical application, described below.

For a claim to satisfy the “tangible” requirement, the claim must set forth a practical application of that judicial exception to produce a real-world result. There is nothing in the record to indicate or suggest whether or why claim 1 does not satisfy the tangible requirement. Applicants respectfully submit that a comparison result as recited in claim 1 has at least one practical application: providing situation-dependent error-handling.

For a claim to satisfy the “concrete” requirement, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. There is nothing in the record to indicate or suggest whether or why claim 1 does not satisfy the concrete requirement. Applicants respectfully submit that, given the same inputs, claim 1 will produce the same result in a repeatable manner.

Based on the analysis set forth in M.P.E.P. § 2106, it is plainly apparent that claim 1 constitutes eligible subject matter. As such, withdrawal of this rejection is respectfully requested.

Claims 2 to 5 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

In summary, claims 1 to 5 are allowable.

CONCLUSION

In view of the foregoing, all pending claims 1 to 5 are allowable – like allowed claims 6 to 8. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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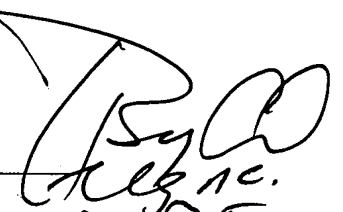
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